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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,525	06/28/2001	Manoel Tenorio	020431.0843	8191

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EXAMINER

CHEN, TE Y

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 08/26/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,525

Applicant(s)

TENORIO, MANOEL

Examiner

Susan Y Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Appeal Brief

This office action is in response to the appeal brief filed on 06/01/2004.

Claim Status

Claims 1-37 are rejected. Applicant's arguments with respect to claims 1-37 have been fully considered but are moot in view of the new ground(s) of rejection.

Applicant may obtain an extension of time under 37 CFR 1.36(a) to file the appropriate appeal fee. The date on which the notice of appeal, the appeal fee, the petition under 37 CFR 1.136(a), and the petition fee are filed will be the date of the reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant respond later than the maximum **SIX MONTH** statutory period of obtain an extension pursuant to 37 CFR 1.136(a) for more than **FIVE MONTHS** beyond the date of reply set in an Office action.

In view of the appeal brief filed on 06/01/2004, the examiner agrees with applicant's arguments of 35 USC § 101 as being not timely, therefore, the examiner withdraw the finality of last office action, **prosecution is hereby reopened**. The Non-final action is set forth below.

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To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 12 and 36, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological art. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological art fail to promote the "progress of science and the useful arts" (i.e.,

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the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In *Bowman* (Ex parte *Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished), the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. Although *Bowman* discloses transforming physical media into a chart and physically plotting a point on said chart, the Board held that the claimed invention is nothing more than an abstract idea, which is not tied to any technological art or environment.

In the present case, although claims 12 and 36 both recite an abstract idea at the preamble for associating target data with a product classification schema, however, the steps in the claim body merely applying a classification taxonomy schema to associate target data with a plurality of product attributes, which can be implemented by the mind of a person or by the use of a pencil and paper. In another words, since the claimed invention, as a whole, is not within the technological arts as explained above, these claims only constitute an idea

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and does not apply, involve, use, or advance the technological arts, thus, it is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claims 1 (lines: 5, 10), 12 (lines: 3, 8), 23 (lines: 3, 8) and 34-37 (lines: 3, 8), the claimed "a first product classification schema" and "a second product classification schema" are new matters, because they are not supported by the original filed specification. Even though, applicant intended to argue that "support for applicant's clarifying amendments and arguments can be found at least at page 21, lines 7-25 and throughout the descriptions of FIGURE 6 located at page 21, line 26 through page 28, line 25 of the Specification" [see the foot note at Page 19 of the amendment filed on 09/11/2003], however, the examiner found no where in the specified pages that define the metes and bounds of the

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claimed first or second schema. Furthermore, there is only one schema – “A SCHEMA” being depicted in the logical flow of the specified Fig. 6. Moreover, none of the steps of the figure 6 differentiates the claimed “a first product classification schema”, “a second product classification schema” from the illustrated “A SCHEMA” of figure 6.

Because the claimed provision of “a first product classification schema” and “a second product classification schema” are considered new matters, as such, the examiner is not treating the features as claimed under either 35 U.S.C. §102 or 103 art rejections.

As to claims 2-11, 13-22 and 24-33, these claims have the same defect as their base claims, hence are rejected for the same reason.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chipman et al. (U.S. Patent No. 6,038,668) in view of McComb et al. (U.S. Patent No. 6,049,673).

As to claims 1, 12, 23, and 34-37, Chipman et al. (hereinafter referred to as Chipman) discloses a network electronic cataloging system [e.g. Fig. 1, Fig. 5; Fig. 6] for associating target data with product classification schema with means, method and computer program product as claimed by applicant to perform the following functions:

- Using the computer system [e.g. the High End Supplier with Page Generator (105), Fig. 1] for accessing the computer product classification schema [e.g. the Portal (102), Fig. 1; col. 4, lines 10-21, col. 5, lines 8-23; col. 6, lines 7-64], which comprising a taxonomy with hierarchical classes into which products is being categorized [e.g., col. 4, lines 9-17; 35- 40], the schema further comprising ontology associated with the classes, each ontology comprising one or more product attributes [e.g., col. 4, lines 16-21; col. 6, lines 58-64];
- Using the computer system [e.g., the Browser of the Low End Supplier(104, Fig. 1), the Internet (101, Fig. 1)] for accessing the target data to be associated with the schema [e.g. the Portal (102), Fig. 1];
- Using the computer system [e.g. the Tool Suite (602), Fig. 6] for determining one or more classes with which at least a portion of the target data is associated based on an automatic comparison between the target data and the product attributes of the ontology [col. 13, lines 43-60];

- Using the computer system [e.g. the Local Portal (607), the Ontology Tracking Component (608), the Web Crawler (609), etc., Fig. 6] for associating at least a portion of the target data with one or more classes in response to determining one or more classes with which at least a portion of the target data should be associated [col. 11, line 61 - col. 12, line 44].

Chipman did not specifically disclose the technique of determination of an association of the claimed target and value of the product schema happened without translating the target data from a schema to other object.

However, McComb et al. (hereinafter referred as McComb) discloses the technique as claimed by applicant. [e.g., Abstract, the OrganicWareTM, col. 4, lines 35 – col. 5, line 13; Fig(s). 3, 5A-5B, 13-17 and associated texts]. Thus, with the teachings of Chipman and McComb in front of him/her, it would have been obvious for an ordinal skilled artisan to modify Chipman's varification tool package with the technique taught by McComb, because by doing so, the modified system can adapt to provide new functionality without the delays and cost imposed by a software verification, therefore result in a reliable system that can be run from one application to another [see McComb: col. 3, lines 18-22, lines 36-40].

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As to claims 2-6, 13-17 and 24-28, except all the features as discussed above, the combined system further discloses that the system associates a portion of the target data with the ontology of the classes by matching name, value, symbols and format [e.g. Chipman: col. 4, lines 10-13; col. 6, lines 14-26].

As to claims 7-8, 18-19 and 29-30, except all the features as discussed above, the combined system further discloses that the system uses vector space [e.g. Chipman: the rank field mechanism, col. 8, lines 5-11; the table between lines 15 –24] and other statistical correlation techniques to identify portions of the target data including values that correspond to values for a product attributes included in the ontology of the classes [e.g. Chipman: the Tool Suite (602), Fig. 6; col. 13, line 39 – col. 14, line 4].

As to claims 10-11, 21-22 and 32-33, the combined system further discloses that the system associates a specific portion of target data with the classes by pointers [e.g. Chipman: col. 2, lines 58 – col. 3, line 6; col. 3, lines 21-26].

As to claims 9, 20, 31, 35-37, except all the features as discussed in claims 1-8, 10-11, 12-19, 21-30 and 32-33. the combined system further teaches that the product attributes, and values is stored in the seller (or

As to claims 9, 20, 31, 35-37, except all the features as discussed in claims 1-8, 10-11, 12-19, 21-30 and 32-33. the combined system further teaches that the product attributes, and values is stored in the seller (or supplier) databases [e.g., Chipman: the Legacy Databases (406) of the supplier system, Fig. 4; col. 10, lines 26-38].

Response to Argument

Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of new ground rejection.

Conclusion

To expedite the process of re-examination, the examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112) set forth by the Examiner prior to the office action, that applicant should provide and link to the most specific page and line numbers of the disclosure where best support is found (see 35 U.S.C. 132).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Reisman (U.S. Patent No. 5,694,546) which discloses a system for automatic unattended electronic catalog transport in a client/server network; Tenorio (U.S. Patent No. 6,778,991) which disclose a dynamic load balancing system for monitoring the electronic commerce transaction traffic by using a product catalog database.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is (703) 308-1155. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (703) 308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susan Y Chen
Examiner
Art Unit 2171

August 20, 2004


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